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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,991	11/20/2001	Gregory Luedtke	219002029100	1704

25225 7590 04/04/2003
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EXAMINER

CHANG, CELIA C

ART UNIT PAPER NUMBER

1625

DATE MAILED: 04/04/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/989,991	Applicant(s) LUEDTKE ET AL.	
	Examiner Celia Chang	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 04 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) 2-9, 11-34 and 40-68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1, 10 and 35-38 is/are rejected.
- 7) ☐ Claim(s) 39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> . | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

1. Applicant's election without traverse of group VII in Paper No. 11 dated Mar. 4, 2003 is acknowledged.

Claims 35-39 and the base claims 1 and 10 to the extent of the elected compounds are prosecuted.

Applicants did not elect a species of claim 68 for method claims thus, claims 2-9, 11-34, 40-68 being drawn to the nonelected inventions are withdrawn from consideration per 37 CFR 1.142(b).

2. Claims 1, 10, 35-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope the claims can not be ascertained because the terms in the claims as "noninterfering substituents", "each of W and X is a spacer of 2-6 Å", "Ar linked to L2 and the atom of the α -ring linked to L1 is at least 5, each said bond having a bond length of 1.2 to 2.0 Å" and/or the distance in space between the atom of Ar linked to L2 and the atom of the α -ring linked to L1 is 4.5-24 Å" (in claim 1), "one or more of the ring carbon atom....is replaced with NR1...." (claim 10) and claims 35-38 structural based on such terms of the base claims are ambiguous and confusing. Is the compound disclosed by Brana CA 137 within the claimed scope or not? Please note that, the distance between the bicyclic ring and Ar corresponding to the structure L1-X-L2 is 5 covalent bond which meet the claim requirement. Since the specification did not disclosed such compounds yet the compounds meet the claims, a 102(f) issue must be raise as to who is the first to invent the "claimed" compounds.

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Further, the smallest spirobicyclic structure as elected in claim 10, formula IV, was found to have a planar size of 62 Å in one plane, and 118 Å in another, therefore, does the claims intend for chemical bonding i.e. bicyclic spiro with specific ring size and elements, or by size i.e. 4.5-24 Å? Please note, not even the smallest structure will meet this double constrain (see CRC handbook p.9-40). Therefore, the scope of the claims can not be ascertained. The following rejections are given the best interpretation of at least 5-covalent bond with a ring structure for the linker.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

Claims 1, 10, 35-38 are rejected under 35 U.S.C. 102(f) as being anticipated by Brana et al. CA 137.

See RN 464201-21-6 has the claimed bicyclic ring being indole, Ar being phenyl and the distance between the bicyclic ring and Ar corresponding to the structure L1-X-L2 is 5 covalent bond which meet the claim requirement. Since the specification did not disclosed such compounds yet the compounds meet the claims, a 102(f) issue must be raise as to who is the first to invent the “claimed” compounds.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1, 10, 35-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Kon et al. CA 118, Hall et al. CA 123, or Biller et al. CA 128.

See CA 118, RN 146760-78-3, CA 123 RN 167828-62-8 or CA 128, RN 163267-06-9 wherein compounds have the bicyclic indolyl, benztriazolyl or dihydrobenzofuranyl ring of the claims and Ar is optionally substituted phenyl of the claims with at least five covalent bond between the two structure corresponding to the L1-X-L2 requirement.

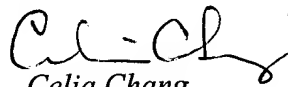
5. Claim 39 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 703-308-4702. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner can be reached by facsimile at (703) 308-7922 with courtesy voice message supra.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

OACS/Chang
Apr.3, 2003


Celia Chang
Primary Examiner
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